

II. Rejection Under 35 U.S.C. § 103

Claims 15-16 and 18-26 stand rejected under 35 U.S.C. 103(a) as allegedly unpatentable over U.S. Patent No. 4,715,686 to *Iwashita* in view of U.S. Patent No. 4,023,977 to *Mercurio*, as evidenced by *Mark* (Encyclopedia of Polymer Science and Engineering). Applicants respectfully disagree with this rejection and traverse at least for the following reasons and further in light of the enclosed Declaration submitted in accordance with 37 C.F.R. § 132.

To establish a *prima facie* case of obviousness there must be a suggestion or motivation to combine the reference teachings and the combination must teach or suggest the elements of the claims. M.P.E.P. § 2143. Here, there is no motivation to make the Examiner's proposed combination nor are all elements thereby taught.

For example, independent claims 15 and 16, *inter alia*, recite "a cellulose ester film comprising a cellulose ester, fine particles having an average particle diameter of 0.01 to 1.0 μm and a polymer ... having a weight average molecular weight of not more than 5,000." Neither *Iwashita* nor *Mercurio*, alone or in combination, teach this claimed subject matter.

The Examiner contends that *Iwashita* teaches a liquid crystal display comprising a polarizing plate having a film comprising a cellulose ester film, but that the reference is deficient in that it fails to teach a cellulose ester film containing the methyl acrylate polymer having an average molecular weight of not more than 5,000. (Office Action dated August 26, 2003, pages 2-3.) The Examiner's secondary reference, *Mercurio*, does not cure this deficiency because it fails to disclose application of the cellulose ester film to the polarizing plate or the liquid crystal display as claimed, much less

application of the cellulose ester film containing fine particles as claimed to the polarizing plate or the liquid crystal display as claimed.

To the contrary, Applicants respectfully submit that *Iwashita* simply teaches a liquid crystal display (see example 5) and a polarizing plate each employing a conventional cellulose ester film (see example 8). *Iwashita* fails to disclose a cellulose ester film containing any additive such as a plasticizer or even fine particles as recited in the instant claims.

Additionally, *Mercurio* discloses a high molecular weight polymer including a cellulose ester (column 7, lines 43-45) containing an oligomer of less than 5,000 weight average molecular weight comprising methyl acrylate monomer (column 2, lines 1-50, & column 7, lines 43-4 5). As the Examiner states, "Mercurio et al. has a 50 micron (μm) (2 mil) film (column 16, lines 10-20) cast from cellulose ester (acetate butyrate) and methyl methacrylate oligomer (column 16, lines 45-55)." (Office Action dated August 26, 2003, page 3, lines 6-7.) *Mercurio* further discloses a polymer cellulose ester film containing pigments (column 9, lines 9-18). However, the particle size of the pigments of *Mercurio* is 10 to 500 microns (see column 9, lines 42-46), preferably 50 to 250 microns, which is far greater than that as claimed.

The Examiner has not shown that the references relied upon, even in combination, teach all elements of Applicants' claims. Thus, no *prima facie* case has been established showing that it would have been obvious to one of ordinary skill in the art to attain the invention over the combination of *Iwashita* and *Mercurio*.

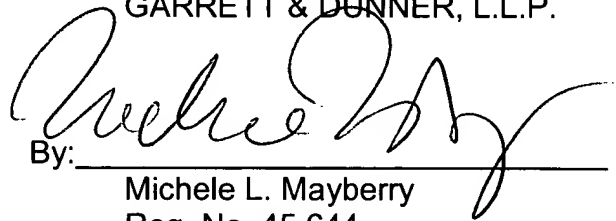
However, in order to further show the unexpected results of the invention, additional comparative tests were carried out employing a combination of the cited

references. The results are shown in an executed Rule 132 Declaration enclosed herewith. As is apparent from Table 5 of the declaration, the inventive film sample 102 exhibits reduced haze as compared with comparative film sample 101. Particularly, the comparative film sample 101 has a haze of 1.0%, which cannot be applied to a polarizing plate or a liquid crystal display. Herein, as described on page 4, lines 1-5, of the Declaration, the polarizing plate sample 101 (comparative) is closest to the invention, among those which are derived from a combination of *Iwashita* and *Mercurio*, since it is different only in size of TiO₂ powder from the polarizing plate sample 102 (inventive). Thus, the invention exhibits greatly improved result over the comparative film. The result is unexpected to one of ordinary skill in the art, and it would not have been obvious to one of ordinary skill in the art to attain the invention over *Iwashita* in view of *Mercurio*. Accordingly, Applicants respectfully request withdrawal of this rejection.

If there is any fee due in connection with the filing of these Preliminary Remarks and Rule 132 Declaration, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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Dated: February 6, 2004

Enclosure: Declaration Under 37 C.F.R. § 1.132

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